UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,769	09/30/2003	Nathanael F. Ehrich	RSW920030073US1	4444

	7590	12/14/2005			EXAMINER	

Gerald R. Woods
IBM Corporation
T81/062
PO Box 12195
Research Triangle Park, NC 27709

EXAMINER
HUYNH, THU V

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<tr><td rowspan="2"></td><td rowspan="2">Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td></tr>
<tr><td>10/674,769</td><td>EHRICH ET AL.</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 September 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 September 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>09/30/03</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: IDS and application filed on 09/30/03.

2.   Claims 1-19 are pending in the case. Claims 1, 13, 18-19 are independent claims.

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on 09/30/03 is in compliance with

the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is

being considered by the examiner.

Specification

4.   The disclosure is objected to because of the following informalities:

Regarding specification page 1, line 5, co-pending application number is missing.

Regarding specification page 4, line 13, the U.S. patent number of related application

serial number 09/504,209 is missing. The US Patent Number 6,681,380 should be used for the

related application.

Regarding specification page 5, line 10, "U.S. Pat. No. _____ (serial number

09/442,015, filed Nov. 17,1999)" should be replaced with "U.S. Patent Application Number

09/442,015, filed Nov. 17, 1999".

Appropriate correction is required.

Claim Objections

5.   Claims 2-12 and 14-17 are objected to because of the following informalities: these

claim recite "the method according to Claim . . . ". The word "Claim" should be replaced

with "claim" (without capital letter C). Appropriate correction is required.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

7.   **Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is**

directed to non-statutory subject matter.

        Regarding claims 1-17, the language of the claims raise a question as to whether the

claims are directed merely to an abstract idea that is not tied to a technological art, environment

or machine which would result in a practical application producing a concrete, useful, and

tangible result to form the basis of statutory subject mater under 35 U.S. C. 101.

        In this case, claims 1-17 recite steps of a method that can be done by a person as a mental

step and/or using pencil and paper. These claims' limitations are not explicitly directed toward

steps being implemented on a computer, computer readable medium, or other statutory device.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   **Claims 1-4, 6-12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by**

Adams et al., US 6,457,030 B1, filed 01/99, patented 09/24/02.

Regarding independent claim 1, Adams teaches the steps of:

- receiving a request for content (Adams, col.5, lines 59-60; col.7, lines 52-58; server

    receiving a request for a web page (HTML document) from a client's pervasive

    device);

- locating a template for the requested content, wherein the template specifies a

    plurality of alternative views of a component that forms a portion of the content

    (Adams, col.5, lines 59-67; col.9, line 37 – col.10, line 26; locating HTML template

    40 (fig.5B) for the requested content, wherein the template specifies many of

    alternative views (fig.5B, alternative images 44a, 44b, 44c, 46a, 46b, 46c) for

    different type of pervasive computer device, so that one of alternative images 44a,

    44b, 44c is selected for replacing image 30 in HTML file of fig.5A. Similarly, one of

    alternative images 46a, 46b, 46c is selected for replacing image 32 in HTML file of

    fig.5A);

- evaluating one or more factors to determine an evaluation result, wherein the

    determined evaluation result corresponds to a particular one of the specified

    alternative views (Adam, col.6, lines 35-47; col.10, lines 11-19; evaluating the

    display capabilities of the pervasive device requesting the web page to decide one of

    alternative images should be used for the replacing); and

- using the particular one of the specified alternative views for the portion of the

content (Adam, col.9, lines 54-58; col.10, lines 11-26; replacing image 30 in the

HTML file in fig.5A with the selected alternative image and displaying the web page

with the selected alternative image via pervasive computing device requesting the

web page).

Regarding claim 2, which is dependent on claim 1, Adams teaches the request is

received from a client and further comprising the step of returning a response to the client,

wherein the response includes the particular one of the specified alternative views (Adams, col.9,

lines 54-58; col.10, lines 1-26; server receives the request for a web page (HTML document)

from a client's pervasive device; selecting one of alternative image for replacing image 30 in the

requested web page and providing the modified requested web page for displaying in client's

pervasive computer device).

Regarding claim 3, which is dependent on claim 1, Adams teaches the requested content

is a particular Web page and the template is a Web page template (Adams, figures 5A and 5B; a

particular web page (fig.5A, HTML document) is requested by the client's pervasive computing

device. The template 40 is a web page template (fig.5B, XML document) that specifies syntax

for selectable alternative images).

Regarding claim 4, which is dependent on claim 1, Adams teaches the template is

specified in a markup language document (Adams, fig.5B, the template 40 is an XML template).

        Regarding claim 6, which is dependent on claim 1, Adams teaches using the determined

evaluation result to identify the particular one of the specified alternative view (Adams, col.10,

lines 11-19; evaluating the display capabilities of the pervasive computing device requesting the

web page to decide one of alternative images should be used to replace the image 30 in the

HTML file of fig.5A).

        Regarding claim 7, which is dependent on claim 4, Adams teaches each of the

alternative views is specified as a child element of a particular parent element, wherein each

child element has as a value its associated alternative view (Adams, fig.5B, alternative images is

specified as child element 44a, 44b, 44c of a particular parent element "<RDF:LI>", wherein

each child element has a value of "BYTES" associated with the alternative view).

        Regarding claim 8, which is dependent on claim 1, Adams teaches the template specifies

alternative views for a plurality of components and wherein the evaluating and using steps apply

to each of the specified components (Adams, col.10, lines 2-26; template specifies alternative

views for many components, such as images 30 and 32 in HTML file of fig.5A. One of

alternative images 44a, 44b, 44c is selected for replacing image 30 in HTML file of fig.5A based

upon display capabilities of the pervasive computer device requesting the web page. Similarly

one of alternative images 46a, 46b, 46c is selected for replacing image 30 in HTML file of

fig.5A).

Regarding claim 9, which is dependent on claim 2, Adams teaches omitting, from the response, the specification of the alternative views which were not selected by the evaluating step (Adams, figures 5A and 5B; col.10, lines 2-26; selecting one of alternative images (for example 44a) to replace the image 30 in the HTML file of fig.5A, leave out the alternative images which were not selected).

Regarding claim 10, which is dependent on claim 7, Adams teaches omitting, from the response, the particular parent element and the child elements which were not selected by the evaluating step (Adams, figures 5A and 5B, selecting one of alternative images (for example 44a) to replace the image 30 in the HTML file of fig.5A, leave out the parent element "<RDF:LI>" and alternative images which were not selected).

Regarding claim 11, which is dependent on claim 1, Adams teaches substituting the selected alternative view for the specification of the plurality of alternative views (Adams, fig.5B; col.10, lines 14-19; substituting the selected alternative view (for example 44a) for other alternative views).

Regarding claim 12, which is dependent on claim 3, Adams teaches using selected alternative view to generate a version of the particular web page reflects the one or more evaluated factors (Adams, col.6, lines 36-47; col.8, line 45 – col.9, line 34; col.9, lines 55-58; col.10, line 11-26; modifying the requested web page based on display capabilities of the pervasive computer device).

Regarding independent claim 18, teaches the steps of:

-   means for receiving a client request for a particular web page (Adams, col.5, lines 59-
    60; col.7, lines 52-58; server receiving a request for a web page (HTML document)
    from a client's pervasive device);

-   means for locating a template for the particular web page, responsive to the means for
    receiving the client request, wherein the template specifies a plurality of alternative
    views of a component that forms a portion of particular web page along with an
    associated selection identifier for each of the specified alternative views (Adams,
    figures 5A and 5B; col.5, lines 59-67; col.9, line 37 – col.10, line 26; locating HTML
    template 40 (fig.5B) for the requested web page, wherein the template specifies many
    of alternative views 44a, 44b, 44c for different type of pervasive computer device, so
    that one of alternative images 44a, 44b, 44c is selected for replacing image 30 in
    HTML file of fig.5A. Each alternative view having an associated selection identifier,
    such as "HIEGHT", "WIDTH", "COLOR", "BYTES" parameter);

-   evaluating one or more factors to determine an evaluation result, wherein the
    determined evaluation result corresponds to a particular one of the selection
    identifiers, thereby selecting the associated one of the specified alternative views
    (Adam, col.6, lines 35-47; col.10, lines 11-19; evaluating the display capabilities of
    the pervasive device requesting the web page, such as "HIEGHT", "WIDTH",
    "COLOR", "BYTES" values of the display device to decide one of alternative images
    should be used for the replacing); and

- using the selected alternative views for the portion when generating the particular

  web page requested by the client (Adam, col.9, lines 54-58; col.10, lines 11-26;

  replacing image 30 in the HTML file in fig.5A with the selected alternative image

  and displaying the web page with the selected alternative image via pervasive

  computing device requesting the web page).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

12.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Adams</u> et al.,

US 6,457,030 B1, filed 01/1999, patented 09/24/02 and in view of <u>Kanevsky</u>, US 6,300,947

B1, filed 07/98, patented 10/01.

Regarding claim 5, which is dependent on claim 1, Adams teaches the template is specified in a scripting language and is embedded in a markup language document (Adams, col.10, lines 1-4, the template 40 is embedded in the HTML file of fig.5A via link 42; "http://foo.com/catalog.meta" includes in the third line of the HTML file of fig.5A). However, Adams does not explicitly disclose the template is specified in a scripting language.

Kanevsky teaches scripting instructions allow produce web pages that fit to a format of a display device (Kanevsky, col.8, lines 2-8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined kanevsky's teaching and Adams' teaching to used script language in the template, since the combination would have provided the template in markup language as well as script language that includes instructions for produce web pages for client's display device as Kanevsky disclosed.

13.   **Claims 13-14, 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over** <u>Adams</u> **et al., US 6,457,030 B1, filed 01/99, patented 09/24/02, and in view of** <u>Narin</u>**, US 6,966,034 B2, filed 01/01.**

Regarding independent claim 13, Adams teaches the steps of:

- determining that content is generated from a particular template, wherein the template specifies a plurality of alternative views of a component that forms a portion of the content and also specifies an associated selection identifier for each of the specified alternative views (Adams, figures 5A and 5B; col.5, lines 59-67; col.8, lines45-57; col.9, line 37 – col.10, line 26; determining that content is generated from template

file http://foo.com/catalog.meta (fig.5B), wherein the template specifies many of

alternative views (fig.5B, alternative view 44a, 44b, 44c) of an image that is used to

replace image 30 in the requested HTML file of fig.5A. The templates specifies

associated selection identifier, such as BYTES parameter that describe characteristic

of the alternative view);

- evaluating one or more factors to determine an evaluation result, wherein the

   determined evaluation result corresponds to a particular one of the selection identifier,

   thereby selecting the associated one of the specified alternative views (Adam, col.6,

   lines 35-47; col.10, lines 11-19; evaluating the display capabilities of the pervasive

   device requesting the web page to decide one of alternative images should be used for

   the replacing); and

- using the particular one of the specified alternative views for the portion of the

   content (Adam, col.9, lines 54-58; col.10, lines 11-26; replacing image 30 in the

   HTML file in fig.5A with the selected alternative image and displaying the web page

   with the selected alternative image via pervasive computing device requesting the

   web page).

However, Adams does not explicitly disclose determining that content *should be*

generated from a particular template.

Narin teaches information identifies the particular web browser and displaying

capabilities of a computer device requesting a web page contains in user-agent request header

and supplemental request header (Narin, col.6, lines 28-31; col.7, lines 21-29; col.8, lines 12-20).

Server receives a request from a client for a web page (Narin, col.3, lines 1-6; col.8, lines 50-51).

Determining whether the supplemental request header and/or user-agent request header exist in

the HTTP request (Narin, col.8, line 58 – col.9, line 6). If one of the headers does exist, selecting

a best-suit web page to the existed header information for sending to the client (Narin, col.9,

lines 3-45). If the request does not include any header, sending a generic response by sending

entire web page as requested (Narin, col.9, lines 46-50).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Narin's teaching into Adams' teaching to determining that

content should be generated from a particular template, since the combination would have

provided a generic web page, such as the web page with image 30 and 32 when a client's

pervasive computer device does not existed.

Regarding claim 14, which is dependent on claim 13, Adams teaches distributing the

generated version of the content to a destination (Adams, fig.1A, "display HTML file with

modified element(s) via pervasive computing device).

Regarding claim 16, which is dependent on claim 13, Adams teaches embedding the

selected alternative view into the generated version of the content (Adams, col.10, lines 11-26;

the modified web page includes the alternative view (for example 44a) which replaced the image

30).

Regarding claim 17, which is dependent on claim 13, Adams teaches embedding an

identifier of the selected alternative view into the generated version of the content (Adams, the

modified web page includes an identifier, such as the alternative view (for example 44a) which

replaced the image 30).

Claim 19 is for a computer program product embodied on computer readable media

(Adams, col.4, lines 51-66; col.5, lines 26-41) performing the method of claim 13 and is rejected

under the same rationale.

14.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Adams in</u>

<u>view of Narin</u> as applied to claim 13 above, and further in view of <u>Beranek</u>, US 6,226,642

B1, filed 09/97, patented 05/01.

Regarding claim 15, which is dependent on claim 13, Adams does not explicitly teach

storing the generated version of the content in a repository.

Beranek teaches "after the Web page has been modified, the modified page is preferably

stored back in the cache at step 271 in order that it may be reused if and when the user desires to

revisit the page at a subsequent time" (Beranek, col.12, lines 31-35).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Beranek's teaching into Adams' teaching to storing the

modified web page for an alternative view in cache, since the combination would have reused the

modified web page if and when the user desires to revisit the page at a subsequent time as

Beranek disclosed.

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Wodarz et al., US 5,999,912, filed 05/97, teaches dynamic advertising scheduling

display, and tracking.

Brown et al., US 5,887,133, filed 01/1997, teaches system and method modifying

documents sent over a communication network.

Blumberg, US 6,708,309 B1, filed 03/99, teaches method and system for viewing

scalable documents.

Sanders, US 6,938,077 B2, filed 11/01, teaches client version advertisement service for

overriding default client version properties.

Takata, US 6,119,136, filed 08/97, teaches Manuscript text composition system featuring

a parameter table for specifying template parameters and characters.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The

examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thu V. Huynh
November 28, 2005